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In re application of
James D. Pylant et al.
Application No. 10/620282
Filed: July 14, 2003
For: BARE DIE TRAY CLIP

**DECISION ON PETITION
TO VACATE FINAL
RESTRICTION REQUIREMENT**

This is a decision on the petition, filed December 21, 2005, under 37 CFR §1.181, seeking review of the decision of the primary examiner. Petitioner requests vacating the species portion of the restriction/election requirement dated June 7, 2005 and to examine all of the apparatus claims.

The petition is **DENIED**.

A review of the file record reveals in an Office Action dated June 7, 2005, an election/restriction requirement was made between claims apparatus and method claims. The Petitioner elected the apparatus, without traverse. The election/restriction requirement further required an election between four species:

- Species 1, represented by figures 5-7
- Species 2, represented by figure 8
- Species 3, represented by figure 9
- Species 4, represented by figure 10.

The Petitioner elected species 1, with traverse, on July 20, 2005, and received an Office action on the merits of species 1 on December 1, 2005, which addressed Petitioner's arguments, and made the restriction/election requirement final and withdrew claims 5-7, 12, 13, 20-22, 24, 25 and 27.

The Petitioner states that all of the species are classified in Class 206, and that the Examiner could easily search all of the subclasses for that art that would be relevant to each species. Further, each of the species operate in the same manner, the species share common design features, and all of the species function as a unitary clip

Although Petitioner states the species overlap in design, function, and operation (arguments 2, 3, and 4), Petitioner stops short of stating that the species are not patentably distinct from each other. Therefore, both Examiner and Applicant consider that the species are patentably distinct. Where an application includes claims directed to different embodiments or species that could fall within the scope of a generic claim, restriction between the species may be proper if the species are independent or distinct (MPEP 806.04). A requirement for restriction is permissible if there is patentable distinction and there would be a serious burden on the Examiner (MPEP 808.01 (a)).

With regard to burden on the Examiner, the Examiner must show by appropriate explanation what the burden entails. In this instance, the Examiner explained in response to the traverse that the original claims received an initial search, and that claimed invention at the time of the restriction contained limitations, which would require additional search beyond that which had already been conducted.

It is clear from the Office action dated December 1, 2005, the Examiner fully considered and addressed the arguments submitted by the applicants. It is also determined the restriction/election requirement between species is appropriate according to the MPEP and rules of practice.

SUMMARY: The Petition to Vacate the Restriction Requirement and examine all the claims present is **DENIED**.



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: James D. Pylant et al.

Group Art Unit: 3677

Serial No.: 10/620,282

Examiner: Jack Lavinder

Filing Date: July 14, 2003

Attorney Docket: PI-015

Title: **BARE DIE TRAY CLIP**

Commissioner for Patents
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Alexandria, VA 22313

**PETITION TRAVERSING ELECTION OF SPECIES
REQUIREMENT UNDER 37 CFR 1.477**

Applicants hereby request the Technology Center Director to overturn the Restriction Requirement made final by the Examiner in the above-identified application on December 1, 2005. The Commissioner is authorized to charge the Petition Fee of \$130 to Deposit Account 50-2991.

On June 7, 2005 the Examiner issued a restriction requirement between the apparatus and method claims. Applicants elected to prosecute the apparatus claims without traverse. Concurrently, the Examiner issued an Election of Species Requirement on the Apparatus claims: Claims 1- 13, 16 -22, 24, 25, and

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27-33. In the Office Action of December 1, 2005, the Examiner identified the following four different species:

- 1) Species #1: Figures 5 -7. Figures 5 and 7 are reproduced below.

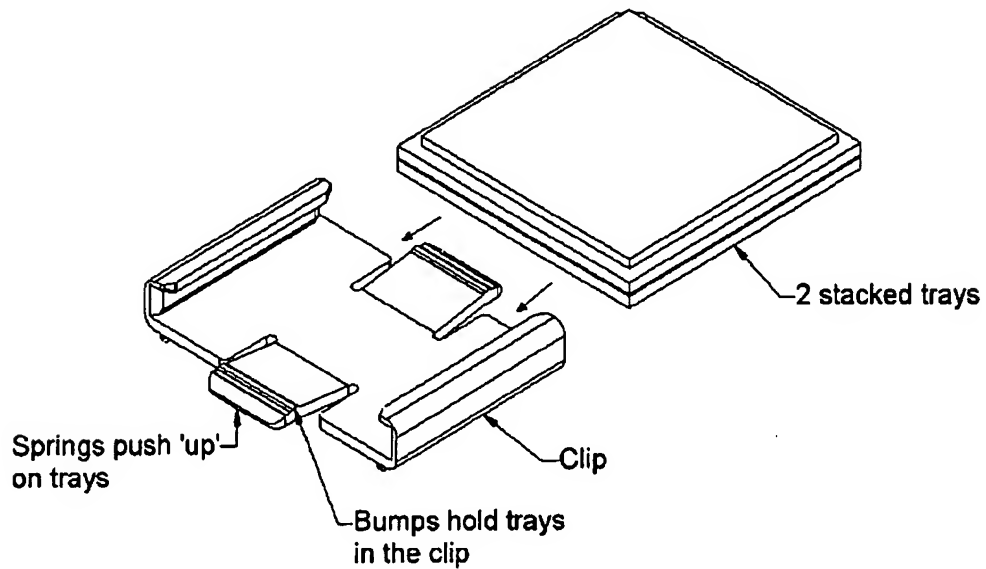


Figure 5 is shown above.

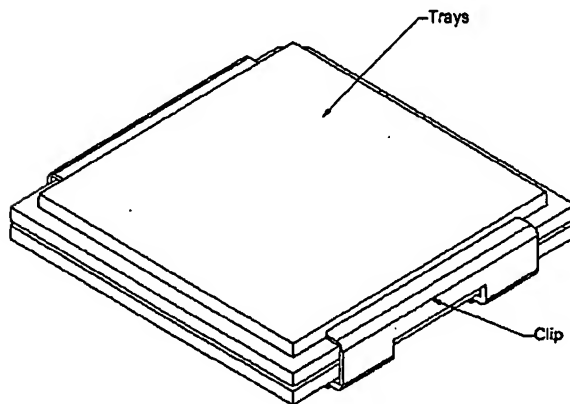
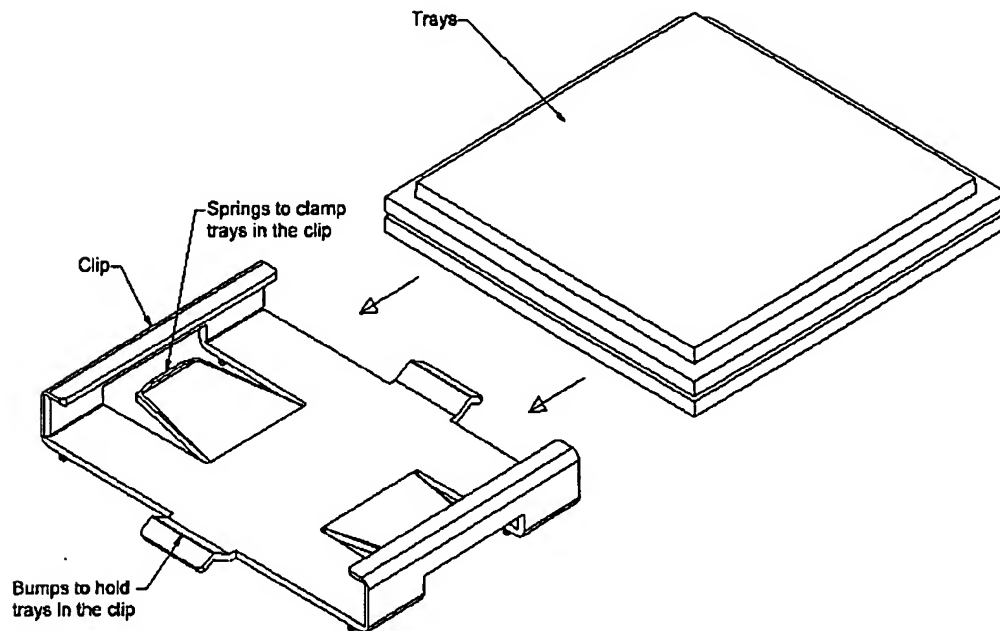


Figure 7

- 2) Species #2: Figure 8, shown in the Appendix;
- 2) Species #3: Figure 9, shown in the Appendix; and
- 3) Species #4: Figure 10, which is reproduced below.



Applicants traversed and requested reconsideration of this Election of Species Requirement in the Amendment filed on September 9, 2005.

In the Office Action dated December 1, 2005, the Examiner made the Election of Species Requirement final. The Examiner stated “there is a considerable burden on the examiner to search all of the claimed species”.

Applicants request the Director to withdraw the Election of Species Requirement for the reasons set forth below.

First, all of the species are classified in Class 206. The Examiner could easily search the same subclasses for art that would be relevant to each species.

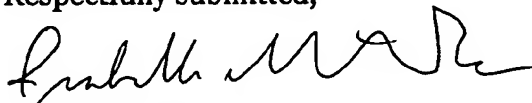
Second, each of Species #1 - #4 operates in similar manner by using pressure members to apply pressure to a portion of the perimeter of a tray. In Fig. 1, pressure members 68, 70 apply an upward force to a portion of the perimeter of the tray. In Fig. 8, pressure member 78 applies the upward force to a portion of the perimeter of the tray. In Fig. 9, the pressure member, 86, also applies an upward force to the tray. While in Fig. 10, pressure members 90, 92 apply an upward force to a portion of the perimeter of the tray.

Third, each of the apparatuses share common design features. For example, the channel in Species #1, 3, and 4 includes a slit between the base and a side of a pressure member.

Fourth, all of the Species function as a unitary clip to clamp together a stack of trays between protrusions and pressure members. An upward force relative to the base is applied by the pressure members to the stack in each species as well.

Since all of the apparatuses overlap in design, function and operation, it is submitted that requiring an Election of Species is improper. Moreover, since all of the claims are classified in the same class, it would be fairly easy for the Examiner to examine all of the apparatus claims together. Accordingly, the Director is requested to withdraw the Election of Species Requirement and permit the examination of all of the Apparatus claims together.

Respectfully submitted,



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APPENDIX

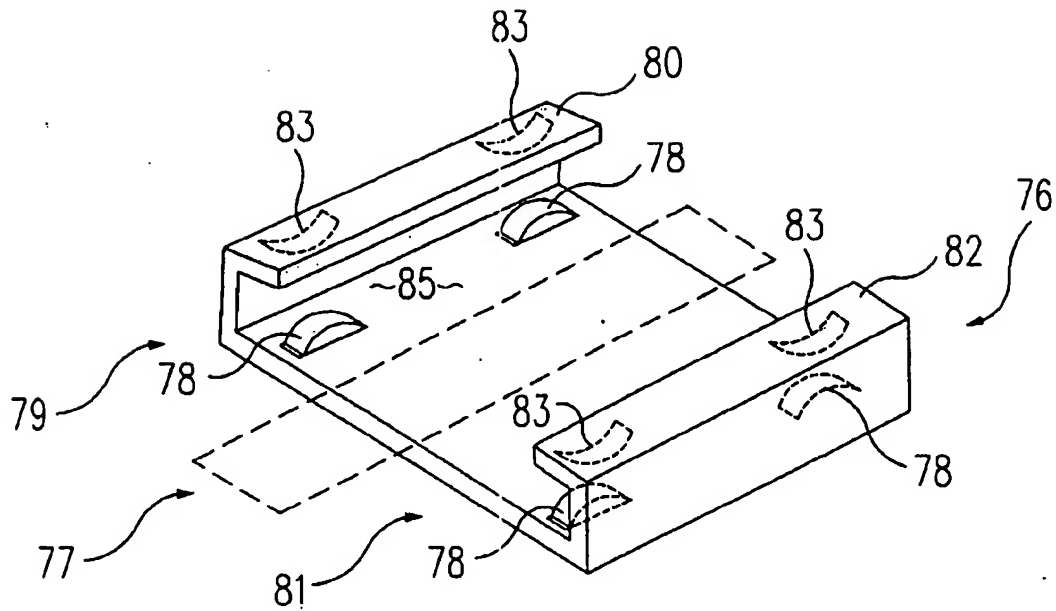


FIG. 8

